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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,674	03/03/2004	Gina Parmar	016778-0474	2300

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FOLEY AND LARDNER LLP
SUITE 500
3000 K STREET NW
WASHINGTON, DC 20007

EXAMINER

LE, DANH C

ART UNIT	PAPER NUMBER
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2617

DATE MAILED: 11/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/790,674

Applicant(s)

PARMAR ET AL.

Examiner

DANH C. LE

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7, 8 and 13-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7, 8 and 13-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/21/06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

- 1. Claims 1-4, 7, 8, 14, 16, 17, 20, 22, 23, 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Lintulampi (US 6,377,804).**

As to claim 1, Lintulampi teaches a method of establishing Universal Mobile Telecommunications System (UMTS) communication between User Equipment (UE) and a UMTS network (figure 4a, 5a), wherein the User Equipment is in communication with a Global System for Mobile communication (GSM)-type network (figure 4A-B and 5A-B), the method comprising:

forwarding UMTS Terrestrial Radio Access Network (UTRAN) parameter transparently to the User Equipment via the GSM-type network (figure 4a, UMTS-RAN sends A-HOack to MS or figure 5a, UMTS SGSN sends MM-RA-updateAccepted to the MS) ; and

in the User Equipment, interpreting the UTRAN parameters and initiating communication with the UMTS network.

As to claim 2, Lintulampi teaches the method according to claim 1, wherein the UTRAN parameter supplied by a Radio Network Controller of the UMTS network (col.2, lines 37-49).

As to claim 3, Lintulampi teaches the method according to claim 1, wherein the UTRAN parameter comprises a list of potential UTRAN access points (col.2, lines 37-49).

As to claim 4, Lintulampi teaches a method according to claim 1, wherein the UE is arranged to establish a link through the Radio Network Controller (RNC) of the UMTS network to the MSC of the GSM-type network (table 5A and 5B, MM-RAC-accepted path).

As to claim 7, the claim is a mean for function claim of claim 1; therefore, the claim is interpreted and rejected as set forth as claim 1.

As to claim 8, Lintulampi teaches a message or data packet in a GSM-type network containing UTRAN parameters for handing over a GSM call to a UMTS network to User Equipment engaged in a GSM call and capable of switching to a UMTS call (figures 5A and 5B).

As to claim 14, the limitation of the claim is the same limitation of claim 3; therefore, the claim is interpreted and rejected as set forth as claim 3.

As to claim 16, the limitation of the claim is the same limitation of claim 3; therefore, the claim is interpreted and rejected as set forth as claim 3.

As to claim 17, the claim is a system claim of claim 3; therefore, the claim is interpreted and rejected as set forth as claim 3.

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As to claim 20, the claim is an apparatus claim of claim 1; therefore, the claim is interpreted and rejected as set forth as claim 1.

As to claim 22, the claim is an apparatus claim of claim 3; therefore, the claim is interpreted and rejected as set forth as claim 3.

As to claim 23, Lintulampi teaches a Radio Network Controller (figure 2, elements 5, 7, figures 4, 5 and their descriptions), comprising:

means for generating the Universal Mobile Telecommunications System (UMTS) Terrestrial Radio Access Network (UTRAN) parameters;

means for forwarding the UTRAN parameters, via the Global System for Mobile communication (GSM)-type network, transparently to the User Equipment (UE) which communicates with the GSM-type network, whereby the UE interpretes the UTRAN parameters and initiates communication with the UMTS network.

As to claim 25, the limitation of the claim is the same limitation of claim 13; therefore, the claim is interpreted and rejected as set forth as claim 13.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over

Lintulampi in view of Le (US 6,556,820).

As to claim 5, Lintulampi teaches a method according to claim 1, Lintulampi fails to teach the potential links supplied in a list to the UE on which satisfactory communication is not possible are deleted from the list of available links. Le teaches the potential links supplied in a list to the UE on which satisfactory communication is not possible are deleted from the list of available links (col.13. lines 2-10). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Le into the system of Lintulampi in order to update on a dynamic basis.

3. Claims 13, 15, 18, 19, 21, 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lintulampi in view of Rinne (US 2001/0046863)

As to claim 13, Lintulampi teaches the method according to claim 1, Lintulampi fails to teach the parameters include one or more of Downlink (DL) channelization code, Uplink (UL) spreading factor, Uplink (UL) scrambling code, Radio Frequency, Radio Link ID, Link Reference, S-RNTI, Transport Format Sets, Transport Format Combination Set and Initial DL Power. Rinne teaches the parameters include one or more of Downlink (DL) channelization code, Uplink (UL) spreading factor, Uplink (UL) scrambling code, Radio Frequency, Radio Link ID, Link Reference, S-RNTI, Transport Format Sets, Transport Format Combination Set and Initial DL Power (paragraph 195, 198). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Rinne into the system of Lintulampi in order to enhance the system performance of the mobile communication system.

As to claim 15, the limitation of the claim is the same limitation of claim 13; therefore, the claim is interpreted and rejected as set forth as claim 13.

As to claim 18, the claim is a system claim of claim 13; therefore, the claim is interpreted and rejected as set forth as claim 13.

As to claim 19, the claim is a system claim of claim 3; therefore, the claim is interpreted and rejected as set forth as claim 3.

As to claim 21, the claim is an apparatus claim of claim 13; therefore, the claim is interpreted and rejected as set forth as claim 13.

As to claim 24, the limitation of the claim is the same limitation of claim 13; therefore, the claim is interpreted and rejected as set forth as claim 13.

Response to Amendment

On page 12, last paragraph, the applicant argues that Lintulampi's system does not pass through UTRAN parameters transparently via a GSM-type network, but instead several components of Lintulampi's GSM-type network interpret and modify the handover information before passing it on to another component by showing that Lintulampi using the different names assigned to the handover signal shown in figure 4.

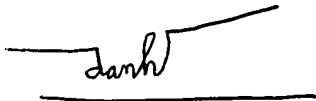
In response, the examiner disagreed, the examiner believes there is no modify the handover information before passing it on to another component as showing figure 4, after UTMS-RAN Accepted Handover Acknowledge which will send Handover command to MS through the GMS system, in particular on figure 5A, the UTMS SGSN sends MM-RA-updateAccepted to the MS.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANH C. LE whose telephone number is 571-272-7868. The examiner can normally be reached on 8:00AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, WILLIAM TROST can be reached on 571-272-7872. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



November 11, 2006
DANH CONG LE
PRIMARY EXAMINER